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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,987	08/31/2001	Arthur D. Taylor	11653-002001	1363

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FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

WILKINS III, HARRY D

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 02/24/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,987

Applicant(s)

TAYLOR, ARTHUR D.

Examiner

Harry D Wilkins, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The objection to claims 1-12 have been withdrawn in view of the amendment of those claims.
2. The rejection under 35 USC 112, 2nd paragraph has been withdrawn in view of the amendment of claim 1.
3. New grounds of rejection are presented in this action, therefore, this action is not final.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Diamond (US 5,384,089).

Diamond anticipates and/or obviates the claimed invention. Diamond teaches (see col 8, lines 21-34, claim 5) a gold alloy that contains 2.0-22.0 wt% Ag, 0.0-2.0 wt% Co, 2.0-47.33 wt% Cu and the balance Au (up to and including 22k (91.67 wt%)).

The ranges of Ag, Co and Cu disclosed by Diamond overlap the presently claimed ranges, thus anticipating those ranges. See MPEP 2131.03.

Alternatively, none of the examples disclosed by Diamond fall within the presently claimed range, however, it would have been within the expected skill of a routineer in the art to have selected values from within the broadly disclosed ranges of Diamond in order to optimize the functions of Ag, Co and Cu, particularly the silver for desired color and malleability (see Peterson at col. 4, lines 6-9), the cobalt for grain refinement (see Diamond at col. 4, lines 38-41) and the copper for desired color and hardness (see Peterson at col. 3, lines 65-69). Changes in temperature, concentrations, or other process conditions of an old process does not impart patentability unless the recited ranges are critical, i.e., they produce a new and unexpected result. In re Aller et al (CCPA 1955) 220 F2d 454, 105 USPQ 233. Only result-effective variables can be optimized. In re Antonie 559 F2d 618, 195 USPQ 6 (CCPA 1977). See MPEP 2144.05 II.

Regarding the presence of other elements in the composition of Diamond, the present claim recites a composition "comprising", which is defined as leaving the composition open to other elements, even in major amounts. See MPEP 2111.03.

Regarding the presence of B in the presently claimed composition, because the presence of B is optional, a reference need not teach its presence in order to anticipate and/or obviate the claim.

Regarding claim 2, Diamond teaches 2.0-22.0 wt% Ag, which overlaps the presently claimed range.

Regarding claims 3 and 4, Diamond teaches 0.0-2.0 wt% Co, which overlaps the presently claimed range.

Regarding claim 5, Diamond teaches (see col. lines 24-25) that the alloy was made by making a master alloy and combining the master alloy with gold. By backing out the composition of Diamond by removing the gold, the composition of the required master alloy would have overlapped the presently claimed composition. Regarding the presence of other elements in the composition of Diamond, the present claim recites a composition "comprising", which is defined as leaving the composition open to other elements, even in major amounts. See MPEP 2111.03. Regarding the presence of B in the presently claimed composition, because the presence of B is optional, a reference need not teach its presence in order to anticipate and/or obviate the claim.

Regarding claims 7 and 8, Diamond teaches (see abstract) that the gold alloys are useful in the casting of jewelry articles.

Regarding claims 6 and 9, Diamond teaches (see col. 2, lines 13-26) combining the master alloy with gold to make a 22k gold alloy.

Regarding claims 10-12, see above regarding claims 2-4.

Response to Arguments

7. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection. However, the examiner would like to respond to Applicant's arguments filed 23 January 2003 that the examples in Diamond are not within the claimed ranges of composition. In response, Applicant is reminded that the disclosure of the prior art should not be construed as being limited only to the

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specific examples contained therein. See *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D Wilkins, III whose telephone number is 703-305-9927. The examiner can normally be reached on M-Th 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Harry D Wilkins, III
Examiner
Art Unit 1742

hdw
February 21, 2003

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700